Remarks

The preceding amendments and following remarks are submitted in response to the Official Action of the Examiner mailed March 31, 2003. Claims 1-4, 6-14, and 16-25 remain pending. Claims 5 and 15 are canceled without prejudice, and claims 21-25 are newly presented. Reconsideration, examination and allowance of all pending claims are respectfully requested.

As a preliminary matter, Applicant submitted two supplemental IDSs on May 6, 2003. Applicant respectfully requests that the Examiner consider these references, and provide initialed copies of the FORM-1449s filed therewith in due course.

In paragraph 1 of the Office Action, the Examiner states that the title of the invention is not descriptive. In response, Applicant changed the title to "ELONGATED ILLUMINATION DEVICE", as the Examiner suggests.

In paragraph 2 of the Office Action, the Examiner objected to the disclosure because the abstract is not in the proper format. In response, Applicant has amended the Abstract to be in the proper format.

In paragraph 7 of the Office Action, the Examiner indicated that claims 5, 6, 10 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 1 has been amended to include the limitations of dependent claim 5, as well as a few clarifying amendments, and claim 5 has been canceled without prejudice. Claim 6 has been amended to be dependent from claim 1. In view thereof, claim 1 is believed to be in

condition for allowance. For similar and other reasons, dependent claims 2-4, and 6-9 are also believed to be in condition for allowance.

Turning now to claim 10. As noted above, the Examiner indicated that claim 10 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 10 has been amended to be in independent form, and includes many of the limitations of original independent claim 1, with certain limitations removed. The limitations of intervening dependent claim 9 have not been included. Notably, claim 10 recites, among other things, that "the slot and elongated member are adapted so that when the elongated member is in the slot, the elongated carrier provides a closing force to the elongated member to help keep the slit in the elongated member in a closed or substantially closed position." Neither Dealey et al. or any other art of record appears to suggest this or other recited features. As such, claim 10 is believed to be in condition for allowance.

Turning now to claim 11. As noted above, the Examiner indicated that claim 15 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 11 has been amended to include the limitations of dependent claim 15, with a few clarifying amendments, and claim 15 has been canceled without prejudice. As such, claim 11 is believed to be in condition for allowance. For similar and other reasons, dependent claims 12-14, and 16-18 are also believed to be in condition for allowance.

In paragraph 3 of the Office Action, the Examiner rejected claims 1, 2, 4, 8, 11, 12, 14, 16 and 18 under 35 U.S.C. §102(b) as being anticipated by Dealey et al. (U.S. Patent No.

5,678,914). For the reasons set forth above, as well as other reasons, claim 1, 2, 4, 8, 11, 12, 14, 16 and 18 are all believed to be in condition for allowance.

In paragraph 4 of the Office Action, the Examiner rejected claims 3, 9 and 13 under 35 U.S.C. §103(a) as being unpatentable over Dealey et al. (U.S. Patent No. 5,678,914). The Examiner states that Dealey et al. suggests all the limitations of the claims, except means for securing the slit into a closed position. The Examiner states it would have been an obvious matter of design choice to use latching means for securing the elongated light source inside the cavity of the elongated member since the applicant has not disclosed that such latching means solves any problem or is for a particular reason. The Examiner further states that it appears the claimed invention would perform equally well with the elastically held elongated light source of Dealey et al.

After careful review, Applicant must respectfully disagree. The Examiner has not provided a single reference that suggests a latching mechanism, and in particular, a latching mechanism for latching a slit into a closed or substantially closed position. As noted in MPEP § 2142:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP 2143.03 states:

> **2143.03 All Claim Limitations Must Be Taught or Suggested**
>
> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As can be seen, to establish a prima facie case for obviousness, the Examiner must provide prior art that suggests all claim limitations. In the present case, the Examiner has not provided a single reference that suggests a latching mechanism, and in particular, a latching mechanism for latching a slit into a closed or substantially closed position, and thus has failed to establish a prima facie case of obviousness.

As noted above, the Examiner states that it would have been an obvious matter of design choice to use latching means for securing the elongated light source inside the cavity of the elongated member since the applicant has not disclosed that such latching means solves any problem or is for a particular reason. However, Applicant has disclosed that the latching means may indeed solve a problem or may be provided for a particular reason. The present specification states, for example:

> Figure 36C is a cross-sectional side view of the insert of Figure 35, with the slit in an open position and with a slit latching mechanism. In the illustrative embodiment, the slit latching mechanism includes a leg with a tooth 712, along with a matching receiving opening 714. As the elongated bumper member 700 is moved into the closed position, the leg 712 slides into the matching receiving opening 714, and the tooth 712 snaps into a corresponding opening in the receiving opening. The latching mechanism may help the elongated bumper member 700 remain in the closed position.

(Emphasis Added) (Specification, page 35, line 22 through page 36, line 6). As can readily be seen, Applicant has disclosed that the latching means may indeed solve at least one problem or may be provided for a particular reason – to help the elongated bumper member remain in the closed position. This may help to, for example, protect the elongated light source from the environment. In Dealey et al., a significant portion of the light source is directly exposed to the environment. Thus, nothing in Dealey et al., or any other cited art, appears to suggest providing a latching means to help the slit remain in a closed or substantially closed position. Further, Applicant does not believe is would have been a simple matter of design choice to include a means for latching the slit into a closed or substantially closed position, as recited in claims 3 and 13. For these and other reasons, Applicant believes that claims 3, 9 and 13 are clearly patentable over the cited prior art.

In paragraph 5 of the Office Action, the Examiner rejected claims 7, 17, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over Dealey et al. (U.S. Patent No. 5,678,914). Applicant notes that of claims 7, 17, 19 and 20, only claim 19 is independent. Claim 19 recites:

> 19. (Currently Amended) An elongated light, comprising:
> an electro-luminescent wire;
> an elongated member having a length with a cavity, the cavity extending along at least part of the length of the elongated member and being adapted for receiving the electro-luminescent wire; and
> an elongated slit that extends along at least part of the cavity, the slit extending ~~from~~ into the cavity through ~~to an outer surface of~~ the elongated member;
> an elongated carrier, the elongated carrier having a slot for receiving the elongated member.

In paragraph 8 of the Office Action, the Examiner states that no prior art was found teaching individually, or suggesting in combination, all of the features of the applicant's invention, specifically the elongated member with the elongated light source being received by an elongated carrier. Applicant agrees. Dealey et al. clearly does not suggest an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member, and an elongated carrier, the elongated carrier having a slot for receiving the elongated member. Therefore, claim 19 is believed to be in condition for allowance. For similar and other reasons, dependent claim 20 is also believed to be in condition for allowance.

With respect to dependent claims 7 and 17, Applicant does not agree that it would have been obvious to substitute an electroluminescent wire (ELEW) for the light source in the system of Dealey et al. Dealey et al. appear to teach to provide the light source outside of the cargo space, and using a light pipe to direct the externally generated light into the cargo space. The use of ELEW, however, would generate light internal to the cargo space. As such, there would appear to be little motivation to substitute an electroluminescent wire (ELEW) for the light source of Dealey et al. For these reasons, as well as the reasons given above with respect to the corresponding independent claims, dependent claims 7 and 17 are believed to be in condition for allowance.

Applicant has also added newly presented claims 21-25. Newly Presented claim 21 recites:

> 21. (Newly Presented) An elongated light for receiving an elongated light source, comprising:
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> an elongated member having a cavity for receiving the elongated light

source and an elongated slit that extends into the cavity through the elongated member; and

an elongated carrier, the elongated carrier having a slot for receiving the elongated member.

As noted above, and in paragraph 8 of the Office Action, the Examiner states that no prior art was found teaching individually, or suggesting in combination, all of the features of the applicant's invention, specifically the elongated member with the elongated light source being received by an elongated carrier. Applicant agrees. Dealey et al. clearly does not disclose or suggest an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member, and an elongated carrier, the elongated carrier having a slot for receiving the elongated member. As such, newly presented claim 21 is believed to be clearly in condition for allowance.

Newly presented claim 22 recites:

22. (Newly Presented) An elongated light for receiving an elongated light source, comprising:

an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member; and

a latch to latch the slit into a closed or substantially closed position.

As can be seen, newly presented claim 22 recites an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member, and means for latching the slit into a closed or substantially closed position. As detailed above, none of the cited art appears to suggest a latch to latch a slit into a closed or substantially closed position. As such, newly presented claim 22 is believed to be clearly in condition for allowance.

Newly presented claim 23 recites:

> 23. (Newly Presented) An elongated light for receiving an elongated light source, comprising:
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> an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member, wherein at least part of the cavity is defined by an at least semi-transparent material that extends from the cavity to an outer surface of the elongated member, and at least part of the elongated member includes a non-transparent material between the cavity and an outer surface of the elongated member.

As can be seen, newly presented claim 23 recites an elongated member that has a cavity for receiving an elongated light source and an elongated slit that extends into the cavity through the elongated member. Claim 23 further recites that at least part of the cavity is defined by an at least semi-transparent material that extends from the cavity to an outer surface of the elongated member, and at least part of the elongated member includes a non-transparent material between the cavity and an outer surface of the elongated member. Nothing in the cited prior art appears to suggest a cavity that is defined by an at least semi-transparent material that extends from the cavity to an outer surface of the elongated member, and wherein at least part of the elongated member includes a non-transparent material between the cavity and an outer surface of the elongated member. Instead, Dealey et al. appears to suggest forming the entire enclosure 96A with a single light transmissive material. Dealey et al. state:

> Enclosure section 96A is made of light transmissive material to allow laterally-emitted light from light pipe 38A to pass into the cargo space.
>
> The light transmissive material forms a light-transmitting panel 104 that is shaped to form a tubular conduit 106 for supporting the light pipe 38A. The conduit 106 includes an elongated longitudinally-oriented slot 108. To install light pipe 38A in enclosure section 96A, an installer need only snap the length of light pipe 38A through the elongated slot 108 and into the tubular conduit 106.
>
> Mounting flanges 100, 102 project in radially opposite directions from one

> another and integrally extend from the tubular conduit 106 of each enclosure segment on opposite sides of the longitudinal slot 108. The flanges 100, 102 are bent, along their lengths, so that they extend outward at a right angle to one another.
>
> Enclosure section 96A is integrally extruded from a single piece of light-transmissive optical material so as to have an elongated shape of a uniform cross-section along its length. The tubular conduit 106 formed by the light-transmitting panel 104 includes a plurality of elongated parallel light-dispersion grooves 110. The grooves 110 perform the dual function of dispersing light, and hiding scratch marks that often form during the extrusion process.

(Emphasis Added)(Dealey et al., column 4, lines 39-63). As can be seen, Dealey et al. suggest integrally extruding enclosure section 96A from a single piece of light-transmissive optical material. As such, newly presented claim 23 is believed to be clearly in condition for allowance.

Newly presented claim 24 recites:

> 24. (Newly Presented) An elongated light for receiving an elongated light source, comprising:
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> an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member, the elongated slit being defined by two slit defining surfaces wherein the two slit defining surfaces are touching one another.

Newly presented claim 24 recites an elongated member that includes a cavity for receiving an elongated light source. Claim 24 also recites an elongated slit that extends into the cavity through the elongated member. Finally, claim 24 recites that the elongated slit is defined by two slit defining surfaces, wherein the two slit defining surfaces are touching one another. In Dealey et al., a slot 108 is defined by two slot defining surfaces that are clearly spaced from one another, and not touching. In particular, Dealey et al. state:

> The light transmissive material forms a light-transmitting panel 104 that is shaped to form a tubular conduit 106 for supporting the light pipe 38A. The conduit 106 includes an elongated longitudinally-oriented slot 108. To install light pipe 38A in enclosure section 96A, an installer need only snap the length of light

pipe 38A through the elongated slot 108 and into the tubular conduit 106. (Emphasis Added)(Dealey et al., column 4, lines 43-49). If the two slot defining surfaces of Dealey et al. were touching one another, an installer could not readily "snap the length of light pipe 38A through the elongated slot 108 and into the tubular conduit 106". In view of the foregoing, newly presented claim 24 is believed to be in condition for allowance.

Newly presented claim 25 is dependent from newly presented claim 24, and further recites that at least part of the cavity is defined by an at least semi-transparent material that extends from the cavity to an outer surface of the elongated member, and at least part of the elongated member includes a non-transparent material between the cavity and an outer surface of the elongated member. Thus, for the same reasons given above with respect to newly presented claim 24, as well as those reasons given above with respect to newly presented claim 23, newly presented claim 25 is believed to be in condition for allowance.

In view of the foregoing, Applicant believes that all pending claims 1-4, 6-14, and 16-25 are now in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner believes it would be beneficial to discuss the application or its

examination in any way, please call the undersigned attorney at (612) 573-2002.

Respectfully submitted,

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By his attorney,

Dated: _____

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